

REMARKS

In response to the above-identified Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Applicant amends claim 9. Applicant does not cancel any claims or add any new claims. Accordingly, claims 1-17 are pending.

I. Objections to the Drawings

The Examiner objected to the Drawings based on the Notice of Draftperson's Patent Drawing Review attached to the Office Action mailed May 11, 2004. Applicant's draftsperson, Patent Reproductions, Inc., filed Formal Drawings on August 11, 2004 with the U.S. Patent and Trademark Office responsive to the issues noted in the Notice. Accordingly, reconsideration and withdrawal of the objection to the Drawings are requested.

II. Rejections to the Claims

Claim 10 is objected to because the Examiner states that it includes informalities. The Examiner states that the phrase "simplified navigation interface" is unclear. Applicant respectfully disagrees.

The Examiner has not specified on what authority he has objected to the claim. The Examiner states that the claim is unclear but has not rejected the language of the claim under 35 U.S.C. § 112, second paragraph. Applicant believes that the phrase "simplified navigation interface" clearly sets forth the subject matter which the Applicant regards as the invention and that the plain meaning of this phrase is clear. The Examiner takes this phrase out of the context of the claim language in which it is used. Claim 10 recites "a simplified navigation interface for web content on a television." It is well known to those of ordinary skill in the art that a standard interface for web content is a browser such as the Internet Explorer by Microsoft Corporation. Thus, a simplified navigation interface for web content may be any navigation interface that has been simplified from the conventional navigation interface for web content. Therefore, Applicant believes that the language of claim 10 is clear to one of ordinary skill in the art and specifically

points out and distinctly claims the subject matter which Applicant regard as the invention. Accordingly, reconsideration and withdrawal of the objection to claim 10 are requested.

III. Claims Rejected Under 35 U.S.C. § 102

Claims 1-17 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,851,149, issued to Xidos (hereinafter "Xidos"). Applicant respectfully disagrees for the following reasons.

To anticipate a claim, each element of the claim must be taught by a single reference. In regard to independent claims 1, 9, and 14, these claims include the elements of "displaying a web based game" or "displaying the game remotely over an Internet at a first location on a first television." Xidos does not teach these elements of claims 1, 9 and 14. The Examiner states that Xidos "teaches that the network used the Internet protocol, therefore the games are web based." While the Applicant agrees with the Examiner that a web based game is a game used over the Internet and provided by a site on the Internet, Applicant respectfully disagrees with the Examiner's characterization of a network that utilizes the internet protocol (IP) as providing games that are web based. Utilization of the IP protocol is not equivalent to stating that a system is part of the Internet. It is well know to those of ordinary skill in the art that the IP protocol specifically, the TCP/IP protocol taught by the invention may be used in local area networks or wide area networks that are not connected to the Internet or not accessible from the Internet. Resources located in such systems that are not available from the Internet would not be considered web based resources. Xidos teaches at col. 2, lines 3-6 that the gaming locations are connected with a back office server through a local area network. The Examiner has not indicated and Applicant has been unable to discern any part of Xidos that teaches the gambling system is available over the Internet to make the system a web based game. Therefore, the Examiner has failed to establish that Xidos teaches each of the elements of claims 1, 9, and 14. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1, 9 and 14 are requested.

Claims 2-8, 10-13, and 15-17 depend from independent claims 1, 9 and 14 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent

claims 1, 9 and 14, these claims are not anticipated by Xidos. Further, the Examiner indicates on pages 4 and 5 of the Office Action mailed May 11, 2004 that Xidos does not teach each of the elements of claims 2, 6 and 15 and that it is necessary to combine additional references under 35 U.S.C. § 103 with Xidos in order to teach and suggest each of the elements of these claims. Thus, the Examiner admits Xidos does not anticipate claims 2, 6, and 15. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 2-7, 10-13 and 15-17 are requested.

IV. Claims Rejected Under 35 U.S.C. § 103

Claims 2 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Xidos in view of U.S. Patent No. 6,312,336 issued to Handelman (hereinafter "Handelman"). Applicant respectfully disagrees for the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must show that the references, combined, teach or suggest each of the elements of a claim. Claims 2 and 15 depend from claims 1 and 14 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 1 and 14, the elements of claims 2 and 15 are not taught by Xidos. Also, the Examiner has not indicated any part of Handelman that teaches displaying a web based game.

Further, claims 2 and 15 include the elements of "displaying a set of game control options in a matrix format." The Examiner argues that "the arrangement of the game control options on the screen is a matter of aesthetic design choice" and that "matters of aesthetic design cannot patentability (*sic*) distinguish over the prior art." However, the Examiner then proceeds to argue that Handelman may be combined with Xidos to teach these elements of claims 2 and 15 and that such combination is motivated to "display a set of game of control options in a matrix format in order to make them easier to find and understand." Thus, Applicant believes the Examiner contradicts himself by relying on an utilitarian function of a matrix format to support his argument for combining Xidos and Handelman. Thus, Applicant believes that the Examiner admits that the

matrix format is not merely an aesthetic design, but rather has a function to improve the ease in which options are found and understood.

The Examiner admits that Xidos does not teach the elements of a displaying game control options in a matrix format. The Examiner seeks to combine Handelman with Xidos to teach these elements of claims 2 and 15. However, Handelman does not teach these elements of claims 2 and 15, and thus does not cure the defects of Xidos. The language of claims 2 and 15 states "displaying a set of *game control options* in a matrix format." The Examiner cites Figures 2A-2E of Handelman as teaching these elements of claims 2 and 15. However, Applicant has reviewed the cited figures and has been unable to discern any part therein that teaches a matrix format for a set of game controls. Rather, the menus displayed in Figures 2A-2E are menus that present information about a set of games in the form of a gaming guide. See col. 7, lines 1-12 and col. 8, lines 6-12 of Handelman. The Examiner has not indicated and Applicant has been unable to discern any part of Handelman that teaches presenting controls for a game in a matrix format. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 2 and 15 based on Xidos in view of Handelman. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 2 and 15 are requested.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Xidos in view of "Know When Your Buddies Are Online" by published by AOL, 1997 (hereinafter "AOL"). Applicant respectfully disagrees for the following reasons.

Claim 6 depends from independent claim 1 and incorporates the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 1, Xidos does not teach each of the elements of claim 6. Namely, Xidos does not teach or suggest a system that displays a web based game. Further, AOL does not cure these defects of Xidos. The Examiner has not indicated and Applicant has been unable to discern any part of AOL that teaches or suggests displaying a web based game.

Further, the Examiner has improperly combined Xidos and AOL. The Examiner must establish that the cited references provide a motivation to combine. See MPEP § 2143.01 "The Prior Art Must Suggest the Desirability of the Claimed Invention." The Examiner states "it would have been obvious to one of ordinary skill of art at the time the invention to have modified Xidos in view of the well known state of the art with regard to chat features ... in order to allow the user to determine if the people he wants to chat with are available, thus fostering the chat feature that is known to attract players." However, the Examiner has not indicated any part of AOL that teaches or suggests the desirability of combining the instant messenger taught by AOL with a gambling system. In fact, providing instant messenger or chat to players of a gambling system may allow those players to collude to undermine the integrity of the gambling system. Further, the Examiner's proposed combination of the Instant Messenger which is based on a PC system with the gambling system of Xidos would alter the fundamental principle of operation for Xidos which is to provide a gambling system on a television through a set top box in a hotel environment. The Instant Messenger program taught by AOL required the resources of a PC such as a mouse and keyboard. See MPEP § 2143.01 "The Combination May Not Change the Principle of Operation of the Primary Reference." Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for Xidos in view of AOL. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 6 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-17 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

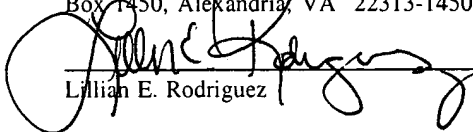
Dated: 8/11, 2004


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 11, 2004.


Lillian E. Rodriguez

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